

REMARKS

Initially, the applicant's representative thanks the Examiner for his helpful remarks during a telephonic discussion of the cited references held on April 25, 2005. During this discussion, the applicant's representative requested a clarification of the rejection of the claims under 35 USC 102 as anticipated by JP 6-38785, since the cited reference does not disclose a pivot plate as recited in the independent claims.

The Examiner indicated that, in his view, the applicant's main frame and pivot plate correspond to a single frame, per applicant's figure 4, and is thus anticipated by JP 6-38785 which shows an ignition apparatus mounted on a vehicle main frame. The applicant's representative suggested amending the independent claims to recite the location of the ignition switch as rearward of the engine so that the electronics within the ignition switch would be less affected by the heat and electrical interference resulting from proximity to the engine. The Examiner indicated that such claim language would be acceptable, and would likely distinguish over the art.

Upon entry of the present Amendment-A the claims in the application are claims 1-18, of which claims 1, 7, 8, and 11 are independent. Claims 1, 7, and 11 have been amended, and new claims 17 and 18 have been added to the application by the present amendment.

The above-identified Office Action has been reviewed, the references carefully considered, and the Examiner's comments carefully weighed. In view thereof, the present Amendment is submitted. Applicant respectfully submits that all of the above amendments are fully supported by the original application. Applicant also respectfully submits that the above amendments do not introduce any new matter into the application. It is contended that by the

present amendment, all bases of rejection set forth in the Office Action have been traversed and overcome. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

In the Claims

Claim Rejections – 35 USC 112

At item 1 of the Office Action, the Examiner has rejected claim 11 under 35 USC 112, second paragraph, as being indefinite, stating that Claim 11 is not complete.

Although the applicant disagrees with this rejection, since claim 11 properly depends from claim 8 and adds additional structure thereto (for example, the motorcycle itself), the applicant has rewritten claim 11 herein in independent form so as to positively and completely recite the features of the claimed invention. As amended, claim 11 avoids rejection under 34 USC 112, second paragraph.

Claim rejections – 35 USC 102

The Examiner has rejected claims 1, 7, and 8-11 under 35 USC 102(b) as anticipated by JP 6-38785 (hereafter referred to as '785), stating that '785 teach an ignition switch apparatus operatively attached to a vehicle body frame 2, on which a drive wheel is supported.

The applicant traverses this ground of rejection, and requests reconsideration and withdrawal thereof.

The Standard for Anticipation

Applicant respectfully wishes to call the Examiner's attention to some relevant cases of the U.S. Court of Appeals for the Federal Circuit (CAFC). The CAFC was established in 1982 to

bring national standards, and a certain level of conformity and continuity to Federal patent case law. Decisions of the Federal Circuit are relevant and helpful in giving guidance to private patent practitioners, as well as to the personnel of the U.S. Patent and Trademark Office.

In the case of *Motorola, Inc. v. Interdigital Technology Corp.*, 121 F. 3d 1461 (CAFC 1997), the Court of Appeals for the Federal Circuit stated:

“For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art (citation omitted). ‘The [prior art] reference must describe the applicant’s claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it’ (citations omitted). **Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there.**” (emphasis added)

The above-quoted passage is consistent with many previous cases of the Federal Circuit and with MPEP 2131, which reiterate the rule that **in order to anticipate a claim, a reference must teach every element of the claim.**

Applicant respectfully submits that ‘785 does not disclose each and every element of applicant’s claimed invention. In particular, ‘785 does not show a pivot plate. The applicant respectfully traverses the Examiner’s assertion that ‘785 anticipates claim 1, 7, and 8, since ‘785 does not disclose all the claimed features of the applicant’s invention.

Upon review of '785, the applicant notes that '785 discloses an antitheft switch attachment apparatus 6 secured to an inner side of an upper frame 2 adjacent to an engine of the vehicle (per English translation of claim 1 and Figures). As best understood from Fig. 2 of '785, the upper frame 2 extends as a single, uninterrupted body downward and rearward from the head pipe 1, and is joined to the rear swing arm in the vicinity of the footrest f. Thus, no pivot plate is disclosed by '785. As best understood from Fig. 1, upper main frame 2 is a hollow pipe with a rectangular cross section. Thus, the structure disclosed by the Examiner as corresponding to a plate is in fact a hollow pipe of rectangular cross section.

As regards claim 1, in view of the Examiner's broad interpretation of the claimed pivot plate of the vehicle body frame, as recited in claim 1, to correspond to "the frame" as a whole, the applicant has amended claim 1 herein to further recite that the ignition switch is positioned rearward of an engine of the motorcycle. This is clearly not shown by '785, in which both Fig. 2 and the translation of claim 1 clearly disclose the ignition apparatus as adjacent the engine 3. As discussed in the applicant's disclosure, the applicant's ignition apparatus includes electronics associated with the inventive radio communication features of the invention. In the inventive arrangement, the ignition apparatus is positioned at a location away from the engine, thereby reducing the exposure of the electronics within the ignition apparatus to both heat and electrical interference generated by the engine.

As regards claim 7, in view of the Examiners broad interpretation of the phrase "between and engine and a rear wheel axle" to include locations at the lateral side of the engine 3 of '785, the applicant has amended claim 7 to recite "rearward of an engine and forward of a rear wheel axle". As discussed above with respect to claim 1, this location is not disclosed or suggested by

the '785 reference and is advantageous.

As regards claim 8, the applicant disagrees that '785 discloses each and every element of applicant's claimed invention, and thus does not anticipate the claimed invention. In claim 8, the applicant clearly recites plural specific, distinct frame structure portions. In particular, claim 8 recites each of a main frame, a pivot plate attached to the main frame, and a rear swing arm pivotally connected to the pivot plate. In contrast, the '785 reference shows a frame 2 directly connected to a swing arm. Because a pivot plate is not disclosed by '785, and further because '785 does not disclose an ignition switch apparatus operatively attached to the pivot plate, claim 8 is not anticipated by '785.

As regards claims 9, the applicant respectfully disagrees that '785 discloses each and every element of applicant's claimed invention, and thus does not anticipate the claimed invention. In particular, '785 does not disclose a pivot plate, as discussed above with respect to claim 8. Moreover, '785 does not show a portion of the ignition switch apparatus extending through the hole.

The '785 reference appears to disclose two separate mounting configurations for the ignition apparatus. As best understood from Fig. 4, '785 discloses a first mounting configuration in which the ignition apparatus is secured to the inside surface of the hollow frame pipe C (that is, upper frame 2) using a bracket B so that the ignition apparatus is disposed adjacent to the underside surface of the pipe C. As best understood from Fig. 3 and the English translation of claim 1, '785 discloses a second mounting configuration in which a guide tube 4 is inserted into the hollow frame pipe 2, and a switch 5 is inserted in the guide tube so that the key hole portion thereof is aligned with a through hole 8 formed on the outer side of the upper frame 2. The

mounting configuration of Fig. 4 of the reference fails to disclose the claimed features, and applicant will thus discuss the Examiner's rejections with respect to the mounting configuration of Fig. 3.

In his rejection of claim 9, the Examiner interprets the hollow frame pipe 2 to correspond to the claimed pivot plate. Although the applicant agrees that '785 discloses holes formed therein, the applicant respectfully disagrees that a portion of the ignition switch apparatus of '785 extends through either of the two holes formed in frame pipe 2. Specifically, since the front portion of the switch 5 is shown in Fig 3 to reside completely within the pipe and is described to arranged such that the "keyhole portion of said switch is exposed to a through hole [8] provided on the outer side of the upper frame", the outer side end of switch 5 is clearly not extending through the hole 8. With respect to the hole formed on the rear of the frame 2, the inner side end of switch 5 is shown in Fig 3 to reside completely within the pipe 2, being spaced from the inner surface of the pipe a distance L and maintained therein by a nut. Thus, the applicant respectfully asserts that no portion of the switch apparatus 5 extends through a hole in the frame pipe 2, as recited in claim 9.

In his rejection of claim 10, the Examiner appears to interpret the guide tube 4 as the recited cylindrical collar which surrounds a portion of the lock cylinder 5. The applicant agrees that guide tube 4 surrounds the switch 5, and extends through the hole formed in the inner side of the frame pipe 2. The applicant respectfully disagrees with this rejection, however, since the '785 reference does not disclose a pivot plate having a hole formed therein, as discussed above with respect to claim 8, from which claim 10 indirectly depends. The applicant further notes that the language of claim 10 is directed to the "business end" of the switch 5, which includes the

keyhole, and the outer side of frame pipe 2. The applicant submits that the inventive feature of providing a collar which extends through the hole and outward from the outerface of the frame is not disclosed or suggested by the '785 reference. New claim 18 is added to the application herein which is a re-wording of claim 10 so as to clearly recite this inventive feature.

As regards claim 11, amended herein to be independent and to include the limitations of claim 8, the applicant respectfully disagrees that '785 anticipates the limitations of this claim for the reasons stated above with respect to the rejection of claim 8.

Claim rejections – 35 USC 103

The Examiner has rejected claims 2-6, and 12-16 under 35 USC 103(a) as being unpatentable over JP 6-38785 in view of Imamura (JP 2002-87368) (hereinafter referred to as Imamura). The Examiner states that '785 teaches the claimed invention except for an antenna for performing radio communication, that Imamura teaches an antenna 5 for performing radio communication, and that it would have been obvious to employ the antenna for performing radio communication for authentication with a transponder built in a key as taught by Imamura in order to improve the anti-theft device.

After careful review of the disclosure of Imamura, the applicant finds that Imamura teaches a keyed ignition system 10 wherein the key 6 includes a transmitter 7, and an annular antenna 5 is provided surrounding the ignition switch 2, which is connected to a steering lock device 3. The ignition system is mounted to an upper bracket 1A of the steering assembly. Upon an agreement between a code transmitted from the key and a stored code, the steering lock device 3 is withdrawn from the steering assembly.

The applicant respectfully disagrees that it would be obvious to modify '785 to include the communication electronics disclosed by Imamura since such a modification would locate these electronics immediately adjacent to engine 3 of the vehicle (Figs. 2 and 3, and claim 1). As disclosed by the applicant, such a placement is highly undesirable since the communication electronics are adversely influenced by engine heat and electrical noise interference from the engine (for example, due to spark plug ignition). These effects make the function of the ignition system unreliable. Because the modification of '785 to include the communications electronics of Imamura would render the ignition system '785 unreliable and perhaps inoperable, such a modification is not obvious.

The applicant respectfully disagrees with the rejection of claim 2, since neither '785, nor '785 as modified by Imamura, discloses an antenna provided in such a manner as to project outwardly beyond an outer face of the pivot plate. As discussed above with respect to claims 9 and 10, Fig. 3 of '785 does not disclose the ignition switch 5 as extending within the hole 8 formed in the outer surface of hollow frame 2, but instead resides completely within the hollow interior of frame pipe 2. Figure 4 of '785 discloses the ignition key apparatus as mounted so that the outer surface of the key housing A lies flush with the outer surface of pipe C. Furthermore, in Figs. 5 and 7 of Imamura, which are cross-sectional views of the upper bracket 1A along line A—A of Fig. 4, and along line B—B of Fig. 6, respectively, the ignition switch portion 2, which includes the antenna therein, is mounted so that its upper edge lies flush with the upper surface of the upper bracket 1A. Thus, because the cited references, considered singly or in combination, do not disclose or suggest an antenna provided in such a manner as to project outwardly beyond an outer face of the pivot plate, claim 2 avoids rejection in view of these references.

As regards claim 3, the applicant respectfully disagrees with the rejection of claim 3 since although Imamura discloses an annular antenna 5, Imamura does not disclose an antenna which has an inner end portion which is substantially aligned with the outer face of the pivot plate, as recited in claim 3. As discussed above, it appears that the antenna is disposed below the outer face of the pivot plate so that the outer end of the ignition portion 2 lies flush with the outer face of the housing 1A (Figs. 5 and 7).

As regards claim 4, the applicant respectfully disagrees with the rejection of claim 4, since although Imamura discloses an annular antenna 5, Imamura does not disclose the antenna acting as a coil to induce power for the transponder. Upon review of the Figures and English language translation of the abstract, as well as a computer-generated translation of the disclosure as obtained on the Japanese Patent Office website, the applicant finds that Imamura does not disclose or suggest powering the transponder through a coil formed by the antenna, and thus does not disclose or suggest the claimed feature.

As regards claim 5, the applicant disagrees that '785 discloses a cover for covering the circumference of the ignition switch, and further disagrees that '785 discloses the cover having an extension portion which covers the side faces of the antenna, as recited in the claim. As clearly shown in Fig. 4, the ignition key apparatus is mounted to the frame pipe C so that the key housing A lies adjacent the underside surface of the frame pipe C and no housing is provided around the key housing A.

As regards claim 6, the applicant disagrees that '785 discloses the cover of claim 5 which further covers a portion of the pivot plate, since '785 does not disclose a cover portion which covers the frame pipe C and/or covers the frame pipe C as well as the circumference of the

ignition switch apparatus. In addition, '785 does not disclose a cover which covers portion of the pivot plate, or vehicle frame pipe 2, at locations proximate a drivers legs, as further recited in this claim. Note that Fig 2 shows the frame pipe 2 as uncovered.

As regards claim 12, the applicant agrees that Imamura discloses a key including a transponder, and an ignition switch apparatus comprising an antenna for radio communication with said transponder. However, the applicant disagrees with the rejection of claim 12 because the teachings of Imamura do not cure the deficiencies of the '785 reference with respect to claim 8, as discussed above.

As regards claim 13, the applicant disagrees with this rejection for the reasons stated above with respect to claim 4, and further because the teachings of Imamura do not cure the deficiencies of the '785 reference with respect to claims 8 and 12, as discussed above.

As regards claim 14, the applicant disagrees with this rejection for the reasons stated above with respect to claim 3, and further because the teachings of Imamura do not cure the deficiencies of the '785 reference with respect to claim 8, as discussed above.

As regards claim 15, the applicant disagrees with this rejection for the reasons stated above with respect to claim 5, and further because the teachings of Imamura do not cure the deficiencies of the '785 reference with respect to claim 8, as discussed above.

As regards claim 16, the applicant disagrees with this rejection for the reasons stated above with respect to claim 6, and further because the teachings of Imamura do not cure the deficiencies of the '785 reference with respect to claims 8 and 15, as discussed above.

For the reasons stated above, the applicant respectfully submits that the claims as listed herein avoid rejection in view of the prior art, and therefore respectfully requests withdrawal of

the rejections of the claims and allowance thereof.

Other Matters

New claims 17 and 18 have been added to the application herein. New claim 17 depends from independent claim 8, and recites the location of the ignition switch apparatus as rearward of the engine. This feature is extremely advantageous in view of the use of the communication electronics found in the applicant's ignition system. That is, placement of the ignition system at a location rearward of the engine avoids the undesirable and negative effects associated with engine heat and electrical interference on the ignition system electronics. New claim 18 also depends from claim 8, and recites that the through hole in the pivot plate is formed in an outwardly facing surface thereof. This feature ensures that the antenna, mounted within this hole, has excellent reception to the exterior of the vehicle. These features are not shown or suggested by the cited prior art references. No new matter is added to the application by these new claims, and the new claims are fully supported by the original disclosure, including specification, claims, and figures.

Conclusion

Based on all of the foregoing, applicant respectfully submits that all of the objections and rejections set forth in the Office Action are overcome, and that as presently amended, all of the pending claims are believed to be allowable over all of the references of record, whether considered singly or in combination. Applicant requests reconsideration and withdrawal of the rejection of record, and allowance of the pending claims.

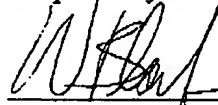
The Commissioner is hereby authorized to charge \$200.00 for one independent claim in excess of three, as well as to charge any deficiency which may be required during the entire pendency of the application, and to credit any excess paid during the entire pendency of the application, to Deposit Account 50-0744 in the name of Carrier, Blackman & Associates, P.C. A duplicate copy of this sheet is enclosed.

If the Examiner is not fully convinced of all of the claims now in the application, applicant respectfully requests that the Examiner telephonically contact applicant's undersigned representative to expeditiously resolve prosecution of the application.

Favorable consideration is respectfully requested.

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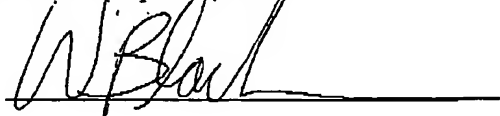
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted, via facsimile, to the United States Patent and Trademark Office on April 27, 2005.



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